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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,410	11/27/2001	Carolynn Rae Johnson	PU010272	7497

7590 05/05/2004  
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EXAMINER

FLETCHER, JAMES A

ART UNIT	PAPER NUMBER
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2615

9

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/994,410

Applicant(s)

JOHNSON, CAROLYNN RAE

Examiner

James A. Fletcher

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 23-39 have been considered but are moot in view of the new ground(s) of rejection, but the examiner will reply to pertinent points.

In re page 9 and claim 23, applicant's representative states, "Figure 3 illustrates an example of a list of recorded programs, wherein each item on the list refers to a performance (or a part of a performance). In the list shown, the performances are referred to by title." Applicant's representative goes on to state, "the items comprising the menu of Okada are not references to 'programs' as recorded performances. Instead, they serve merely to identify specific directories and files stored on a storage medium. The example filename 'movie2.vob' shown in Figure 77A is a convenient reference to a specific file containing data, not a reference to the subject matter or artistic content of a recorded performance."

The examiner notes that the broadly claimed "program list" of claim 23 makes no mention of a title that refers to the subject matter or artistic content of a recorded performance.

Further in re pages 9 and 10 and claim 23, applicant's representative states, "Okada does not disclose or suggest prompting a user 'to select a recorded program to be included in a second list of recorded programs'."

The examiner respectfully disagrees. In addition to the simple selection of a program shown in Fig. 77A, Figs 85-90 illustrate in detail the method of creating a second list of programs taken from the original program list.

***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 27-39 been renumbered 26-38.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 28-30 as originally numbered are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the claims depend on nonexistent claim 26. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

5. Claim 39 as originally numbered is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the claim depends

canceled claim 1. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 23, 25-26, 30-31, and 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada (6,181,870).

**Regarding claims 23 and 31 (formerly 32),** Okada et al disclose a video program list, comprising the steps of:

- presenting a menu which including a first program list of recorded programs (Fig 77A shows a menu that includes a directory with a plurality of files named "MovieX.VOB");
- prompting a user to select at least one recorded program from the first program list to be included in a second program list (Fig. 77A, "Press one Key");
- creating the second program list, including the at least one identified program (Fig. 77B "Specify desired cell section to be partially reproduced between first original PGC and third original PGC");
- creating an identifier corresponding to the second program list (Fig 77B shows Orig\_PGC#1, Orig\_PGC#2, and Orig\_PGC#3);

- including the identifier as a selectable item of the menu (Fig.85 shows “User\_DefinedPGC#1” as being ready to be added to the menu once it has been defined in the compilation step above).

**Regarding claim 25**, Okada discloses a method of creating a video program list wherein the programs are represented on the menu by means of a program title (Fig 85 shows a programming screen identifying the various programs with titles of “Cell #xx, where xx is a number).

**Regarding claim 26 (formerly 27)**, a method of creating a video program list comprising the steps of:

- prompting the user to select an order for the programs comprising the second list (fig. 42 “Desired Reproduction Order Set in File” and Col 59, lines 20-26 “real ‘edit’ operation has the DVD recorder 70 cut out each section indicated as a cell from an AV file recorder on a DVD-RAM, set the cut-out sections as separate files, and link a plurality of cut-out sections in accordance with the reproduction order shown by a program chain. Such edit operations are analogous to the cutting of a movie film at the marked positions and the splicing of the cut sections together”); and
- playing back the video programs comprising the second list in the selected order (Col 61, lines 47-49 “the AV data editing unit 15 treats the plurality of cells as a program chain, based on the chosen reproduction order”).

**Regarding claim 30 (formerly 31)**, Okada discloses a system for generating a video recording and playback list, comprising the steps of:

- a display device capable of displaying a program menu including a plurality of individually selectable programs (Figs 85-90 show a menu with a plurality of recorded programs listed);
- the device operable to allow a user to indicate at least two individual ones of the plurality of programs (Figs 86A-89B show the method of creating a user defined PGC from several programs);
- the device including a processor programmed to create a list comprising the indicated programs, and to provide an identifier corresponding to the list (Figs 88A-89A "User\_DefinedPGC#1");
- the processor programmed to modify the menu to include the identifier as a user selectable item of the menu (Fig 90 shows several original PGCs and several User Defined PGCs).

**Regarding claim 33 (formerly 34),** Okada discloses a system for generating a video recording and playback list wherein the device is operable to allow a user to order the indicated items and wherein the processor is further programmed to playback the programs according to the order in response to user selection of the identifier (Col 59, lines 54-62 "When the file "AV\_FILE#1" is in the focus state and the user presses the "PLAY" key on the remote controller 71, the recording-editing-reproduction control unit ...selects the AV data reproduction unit 14 as the component capable of performing a play operation, and instructs the AV data reproduction unit 14 is reproduce the AV file indicated as the operation target" and Figs 92A and 92B illustrate the selection of a User Defined PGC for playback).

**Regarding claim 34 (formerly 35),** Okada discloses a system for generating a video recording and playback list wherein the processor is further programmed to automatically transfer all programs comprising the list from a first storage medium to a second storage medium in response to a single user selection of the identifier (Col 93, line 62 - Col 94, line 2 "the editing multi-stage control unit 26 instructs the title reproduction control unit 23 to reproduce the VOBs in accordance with the PGC, out of the user-defined PGCs, that has been indicated by the user" and Col 93, lines 13-16 "the user-defined PGC information table that includes the new user-defined PGC generated in the PGC information table work are 21" is transferred to the RTRW management file work area").

**Regarding claim 35 (formerly 36),** Okada discloses a system for generating a video recording and playback list wherein the processor is further programmed to allow the user to specify the identifier (Col 3, lines 33-35 "the user being able to select a most suitable of the intermediate video editing patterns at a later date").

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 24, 32, and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada as applied to claims above, and further in view of Saito et al (6,085,020).



**Regarding claims 24 and 32 (formerly 33),** Okada suggests a method and system of creating a video program list wherein the recorded programs are stored on multiple media (Fig 77B shows a plurality of Orig\_PGC files), but does not specifically disclose that they are on separate media.

Saito et al teach a method and system of creating a video program list wherein at least a first recorded program of the plurality of recorded programs is stored on a first storage medium and at least a second recorded program of the plurality of recorded programs is stored on a second storage medium (Fig 4 shows a video editing device with a plurality of hard disk drives 31 used for storage of video data, as discussed in Col 8, lines 62-65 "The SCSI hard disk drive 31 is a recording medium to be used for recording AV information. Such hard disk drives, each with the interface unit 30, are installed in the quantity required to process the AV information").

As suggested by Okada and taught by Saito et al, multiple media for sources of program material can provide for increased storage and versatility, and are well-known, widely used, and commercially available.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Okada to provide multiple sources for the video program data.

**Regarding claims 36 and 37 (formerly 37 and 38),** Okada discloses a system for generating a video recording and playback list wherein the second storage medium is selected from the group comprising: optical disc media, magneto disc media, digital tape media, analog tape media, and hard disc drive [HDD] (Col 2, lines 42-44 "a video

Art Unit: 2615

editing setup that utilizes a recording medium which allows random access, such as a hard disc or phase change-type optical disc”).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fletcher whose telephone number is (703) 305-3464. The examiner can normally be reached on 7:45AM - 5:45PM M-Th, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached at (703) 308-9644.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, DC 20231


**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only).**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

JAF  
April 30, 2004

  
VINCENT BOCCIO  
PRIMARY EXAMINER